

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: FUJIWARA=4

In re Application of:) Confirmation No.: 5657
)
Makoto FUJIWARA et al) Art Unit: 1625
)
Appln. No.: 10/564,039) Examiner: N.S.Chandrakumar
)
Filing Date: January 10, 2006) December 13, 2007
)
For: AMINE COMPOUND AND USES THEREOF)
)

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop: Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are in receipt of the Office Action
mailed November 16, 2007, entirely in the nature of a
restriction requirement purportedly based on lack of unity of
invention under the applicable PCT Rules 13.1 and 13.2.

Applicants reply below:

First, however, applicants respectfully request the
PTO to acknowledge receipt of applicants' papers filed under
Section 119.

Restriction has been required among what the
examiner considers to be six (6) separate inventions, which

applicants understand are deemed by the PTO as being patentably distinct from one another, i.e. *prima facie* non-obviousness from one another. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, with traverse and without prejudice.

The holding of lack of unity of invention is predicated on the assumption that the common technical feature is the chromenome ring system which is shown by JP 11-247449. Applicants respectfully disagree and enclose herewith an abstract of JP 11-247449. Applicants disagree because the compound called for in claim 1 is an amine compound represented by Formula 1, clearly distinguish from the compound of JP 11-247449 **at least** at the point wherein the amine compound contains a tertiary amine group. Thus, JP 11-247449 neither anticipates applicant's claims nor makes them obvious.

As claim 1 is patentable over any know prior art, and as claim 1 defines the common technical feature under PCT Rules 13.1 and 13.2, and as claims 2-6 all incorporate the same common technical feature, all of claims 1-6 read on the elected subject matter.

Withdrawal of the requirement and examination of all the claims on the merits are therefore respectfully requested.

Appln. No. 10/564,039
Reply dated December 13, 2007
Reply to Office Action of November 15, 2007

Applicants wish to briefly add an additional comment with respect to claims 1 and 2 which are directed to the compound per se. It is clear that claim 1 is generic and claim 2 is further limiting, defining a sub-group of the amine compounds called for in claim 1. Applicants know of no justification for restricting between two claims which are directed to the same subject matter, one such claim being more limited and being dependent on the other. If restriction were proper under such conditions, then no U.S. patent application would ever contain a dependent claim which was patentable "as a whole" if the claim from which it depended were not patentable. Applicants believe and respectfully submit that such a position of the PTO would be contrary to the law and well establish practice.

Applicants respectfully await the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By



Sheridan Neimark
Sheridan Neimark
Registration No. 20,520

SN:tdd

Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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